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Supreme Court of the United States

OCTOBER TERM, 1944.

No. 1193

WISCONSIN ALUMNI RESEARCH FOUNDATION,

Petitioner,

vs.

VITAMIN TECHNOLOGISTS, INC., and H. F. B. ROESSLER,

Respondents.

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR CERTIORARI.

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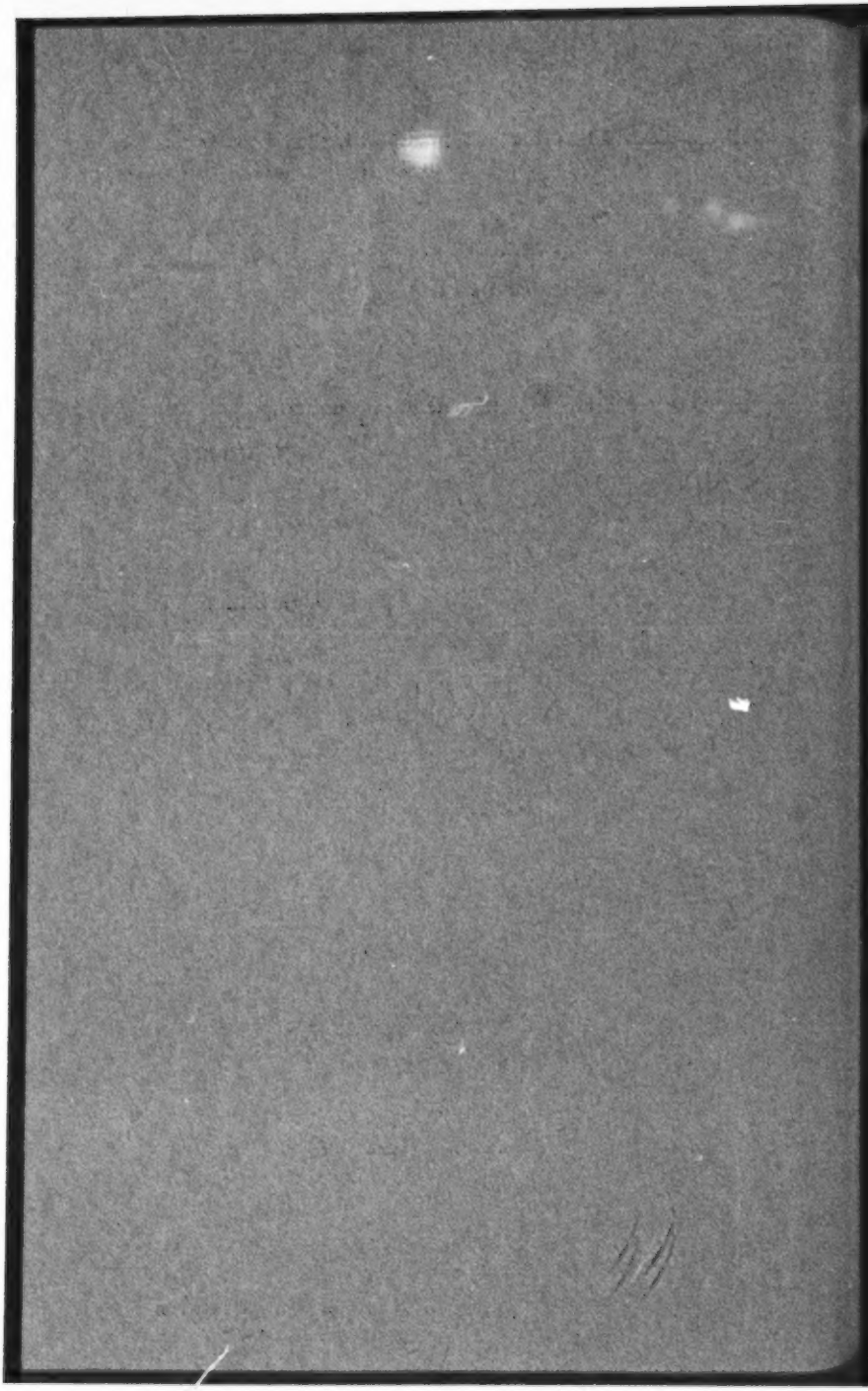

SUBJECT INDEX.

PAGE

Petitioner's questions 1 and 2. Re misuse of patents..... 2

First patent 8

Petitioner's third and fourth questions. Re scope of claims..... 9

Petitioner's fifth and sixth questions. Re claims indefinite..... 10

Petitioner's seventh, eighth and ninth questions. Re Hume and Smith and Goldblatt and Soames publications..... 16

Petitioner's tenth question. Re yeast patent..... 19

Alleged divergence of views expressed in opinions of the Circuit Court of Appeals..... 22

Re pages 12-29 of petitioner's brief..... 24

Summary 26

Conclusion 28

TABLE OF AUTHORITIES CITED.

CASES.	PAGE
Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403	15
Chapman v. Wintroath, 252 U. S. 126	20
Crown Cork Co. v. Gutman Co., 304 U. S. 159	21
Dewey & Almy Chemical Co. v. Mimex Co., 124 F. (2d) 986	17
Farmers' Cooperative Exchange v. Turnbow, 111 F. (2d) 728	13
Fullerton Walnut Growers Association v. Anderson-Barngrover Mfg. Co., 166 Fed. 443	15
General Electric Co. v. Wabash Co., 304 U. S. 364	10, 13, 28
General Talking Pictures Corp. v. Western Electric Co., 304 U. S. 175	5
Keller v. Adams-Campbell Co., 264 U. S. 314	5
Layne & Bowler Corporation v. Western Well Works, Inc., et al., 261 U. S. 387	5
Magnum Import Co. v. Coty, 262 U. S. 159	4
Mercoid Corp. v. Mid-Continent Inv. Co., 320 U. S. 661	3
Minerals Separation, Ltd. v. Hyde, 242 U. S. 261	13
Morton Salt Co. v. G. S. Suppiger Co., 314 U. S. 488	3
National Grain Yeast Corp., 308 U. S. 34	13
Overland Motor Co. v. Packard Motor Co., 274 U. S. 417	21
Smith v. Snow, 294 U. S. 1	15
The American Graphophone Co. v. Leeds, et al., 87 Fed. 873	17
United Carbon Co. v. Binney and Smith Co., 317 U. S. 228	10, 11, 28
United States v. Johnson, 268 U. S. 220	4
United States v. Masonite Corp., 316 U. S. 241	3
Vegetable Oil Products Co. v. Dorward & Sons Co., 60 U. S. P. Q. 4, 53 F. Supp. 281	9

PAGE

Waxham v. Smith, 294 U. S. 20 15

Webster Elec. Co. v. Splitdorf Elec. Co., 264 U. S. 463 ..... 20, 21

Wirebounds Patents Co. v. Saranac Automatic Machine Corp., 65 F. (2d) 904 20

Woodbridge v. United States, 263 U. S. 50 20

STATUTES.

Revised Statutes 4888 (35 U. S. C. A. 33) 10, 16

TEXTBOOKS.

Robertson and Kirkham, Jurisdiction of the Supreme Court of the United States (1936), p. 665 7

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

The petition for certiorari herein formulates ten questions (Petition pp. 6-10) which petitioner asks this Court to consider and adjudicate. These "Questions Presented" comprehend two distinct subject matters. Some of the "Questions Presented" by the petitioner are incomplete, misleading, superfluous, and are not based on the facts in this case.

The first and second questions presented relate to the Petitioner's misuse of its patents in suit. However, the opinions of the Circuit Court of Appeals [R. 3308-3346, 3478-3486] clearly demonstrate that neither of said questions is involved in this case.

Petitioner's Questions 1 and 2. Re Misuse of Patents.
(Petitioner's Br. pp. 29-34.)

The questions with respect to the petitioner's misuse of its patents (Questions Presented 1 and 2, pp. 6 and 7) cannot be properly raised or presented in the petition for certiorari because the Circuit Court of Appeals did not base its decision on that ground. Although the Circuit Court of Appeals said that the petitioner's acts "*warrants* the refusal of the equitable injunctive and accounting relief sought," nevertheless the Court held that the public interest is served better by holding that the patents are invalid. The opinion of the Court is explicit in this respect and reads as follows:

> "* * * Since our consideration of the record convinces us that the patents are invalid, we have concluded that equity will best be served by disposing of the case on that ground." [R. 3322, 146 F. (2d) 941, at pp. 946, 947.]
>
> "* * * We further hold that such refusal to permit such irradiation warrants the refusal of the equitable injunctive and accounting relief sought by the corporation, though we hold the public interest is served better by our decision that the patents are invalid." [R. 3485, 146 F. (2d) 941, at p. 956.]

Even though the lower Court had based its decision on that ground the first question is at least superfluous since it makes no mention whatever of either the public interest or of the public health involved.

If the first or second question were involved in this case (and we respectfully submit neither of said questions is properly presented herein), respondent* would strongly

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*The corporate respondent will be referred to as the respondent herein, since this petition is not concerned with the dismissal as to individual liability of defendant Roessler. (Petition p. 1.)

contend that the question should necessarily be answered in the affirmative.

Furthermore, even though the Circuit Court of Appeals had based its decision on the petitioner's refusal to permit its processes to be used in the irradiation of oleomargarine, and thus prevent the aid to or cure of rickets in its consumers, the Court would merely have been following the principle established in many recent decisions of this Court. See *Morton Salt Co. v. G. S. Suppiger Co.*, 314 U. S. 488; *United States v. Masonite Corp.*, 316 U. S. 241; *Mercoid Corp. v. Mid-Continent Inv. Co.*, 320 U. S. 661, and other cases cited by the Circuit Court of Appeals in the majority opinion of the Court. [R. 3314-3322, 146 F. (2d) 941, 944-946.]

This Court said in *Morton Salt Co. v. G. S. Suppiger Co., supra*, at page 33:

> "* * * The patentee, like these other holders of an exclusive privilege granted in the furtherance of a public policy, may not claim protection of his grant by the courts where it is being used to subvert that policy."

Petitioner contends that the decision of the Circuit Court of Appeals in this respect is "in direct conflict with the decision of this Court in the Paper Bag Patent Case (Continental Paper Bag Company v. Eastern Paper Bag Company, 210 U. S. 405)." That contention cannot stand for two reasons, namely:

1. As shown above, the Circuit Court did not base its decision on the petitioner's misuse of its patents, and

2. As stated in the majority opinion [R. 3321]:

> "* * * There (referring to Paper Bag case) it is held that the suppression of the use of a patent for

paper bags was not against the public interest, but the Court's opinion, at page 430, concludes with this statement '* * * Whether, however, a case cannot arise where, regarding the situation of the parties in view of the public interest, a court of equity might be justified in withholding relief by injunction, we do not decide.'" (Parentheses added.)

There was no disagreement between the three Circuit Judges on this matter. All three Judges concurred in concluding that the refusal was unwarranted, against the public interest, and warranted the refusal of the equitable relief sought by petitioner. [R. 3485, 146 F. (2d) at p. 956.]

Furthermore, even if the first and second questions were properly presented, the petition should still be denied, in that with respect to the remaining questions, this case is an ordinary patent infringement case with the usual issues of anticipation and invention, with no conflict of decision with respect to the petitioner's patents between two Circuit Courts of Appeals. This Court has consistently held that the writ of certiorari will not issue to review the questions of anticipation, invention, and infringement unless it is necessary to reconcile decisions of Circuit Courts of Appeals on the same patent. *United States v. Johnson*, 268 U. S. 220; *Magnum Import Co. v. Coty*, 262 U. S. 159, 163.

A decision on the first and second questions propounded alone would not entitle the petitioner to prevail, since the respondent would still prevail by reason of the Court's decision that the patents in suit are invalid.

In *Layne & Bowler Corporation v. Western Well Works, Inc., et al.*, 261 U. S. 387, this Court said at page 393:

> "* * * it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. * * *"

In *Keller v. Adams-Campbell Co.*, 264 U. S. 314, this Court said at page 319:

> "* * * Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent. * * *"

The decision of this Court in *General Talking Pictures Corp. v. Western Electric Co.*, 304 U. S. 175. on pages 178 and 179, states the law as follows:

> "* * * Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it. * * * Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues, for as to them there is no conflict between decisions of circuit courts of appeals. * * *"

From the above, it is evident that this Court would not grant a writ of certiorari in this case if the Circuit Court of Appeals had made no mention whatever of the petitioner's misuse of its patents. The fact that the petitioner has misused its patent should not be the basis of

giving it another hearing on matters peculiar to this controversy.

The petitioner (Petition p. 11) urges that an exception be made to the general rule set forth above because of:

(1) The divergence of views expressed in the opinions below,

(2) The importance of the questions propounded, and

(3) The conflict between the decision of the Court of Appeals and previous decisions of this Court.

With respect to these matters, we respectfully submit:

(1) That the divergence of views expressed by the Circuit Court Judges does not warrant the granting of certiorari, since as stated in the cases quoted from above "there must be a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal." Although the petitioner contends that there is a divergence of views expressed in the opinions below as to most of the questions propounded, there is no basis for this contention as we will demonstrate to this Court in a later section entitled "Alleged Divergence of Views Expressed in Opinions of the Circuit Court of Appeals."

(2) The case does not involve any principle which is of importance to the public, other than the questions with respect to the misuse of the patents, and, as shown above, the Circuit Court of Appeals did not base its decision on the misuse of the patents.

(3) There is no merit in the petitioner's contention that the decision in this case conflicts with previous decisions of this Court.

See also the statement in Robertson and Kirkham, "Jurisdiction of the Supreme Court of the United States," 1936 (West Publishing Co., St. Paul, Minn., publishers), on page 665, which reads as follows:

> "* * * In addition, in the usual course of litigation of ordinary issues of patent validity and infringement, the opportunity exists and is exercised of having suits involving the same or substantially the same issues, brought and determined in several circuits; and in this process it may reasonably be expected that issues of fact will be thoroughly explored by the courts primarily charged with the duty of determining patent controversies, and that any error in the appreciation of facts will ultimately show in conflicting decisions."

The above statement is particularly true in this case. Petitioner instituted an action in the District Court of the United States for the Northern District of Illinois, Eastern Division, against Rene Douglas, doing business as Douglas Laboratories, Case No. 43C-704, for the alleged infringement of the first two patents in this cause. The United States of America, by its attorneys, intervened and as counter-claimant filed a counterclaim against petitioner; E. I. DuPont de Nemours and Company; The Quaker Oats Company; Standard Brands Incorporated; Gelatin Products Corporation; The Borden Company; Carnation Company; Pet Milk Company; Indiana Condensed Milk Company; Nestle's Milk Products, Inc.; Vitamins, Inc.; Abbott Laboratories; Mead Johnson & Company; The Wm. S. Merrell Company; Parke, Davis

& Company; E. R. Squibb & Sons; Winthrop Chemical Company, Inc., and Charles Bowman, as counter-defendants, based upon the misuse of said patents by the petitioner herein and the above-named counter-defendants. Respondent is informed and believes that said action is still pending and that it has not been brought to trial to date. Respondent is a small corporation with limited funds and was financially unable to explore the question of the misuse of the patents by the petitioner and its licensees in detail. In fact, respondent did little more than compel the petitioner to disclose the license agreements which are in evidence. The attorneys for the United States of America will undoubtedly prove many more facts dealing with the misuse of the patents in suit. We therefore submit that the pendency of the above-mentioned suit against Rene Douglas is another reason why the petition for certiorari should be denied.

First Patent.

The third, fourth, seventh, eighth and ninth questions are directed *solely* to the *first patent*, that is, patent number 1,680,818, dated August 14, 1928. Questions five and six are directed to the first and second patents. In order for the petitioner to prevail on the first patent, each and every one of the first nine questions presented must be answered in accordance with the petitioner's contentions.

Furthermore, it should be noted that the first patent expires on August 14, 1945. [R. 2277.]

Petitioner's Third and Fourth Questions. Re Scope of Claims. (Petitioner's Br. pp. 35-43.)

These questions relate to the validity of the first patent and are purely questions of fact. No question of law is involved. That this is true is clearly shown by the fact that the petitioner cites no cases whatever with respect to these questions other than *Vegetable Oil Products Co. v. Dorward & Sons Co.*, 60 U. S. P. Q. 4, 53 F. Supp. 281. (Petitioner's Br. p. 42.) This case was cited on the point as to whether or not the process is nothing more or less than a law of natural science and therefore is not patentable, which is not in point as to either the third or fourth question.

Furthermore, both the third and fourth questions presented are incomplete and misleading. For example, neither question makes any mention of the following facts:

(1) that the specification states that a quartz mercury vapor light, "open flame carbon arc, or other source of light may be employed in effecting the activation" [R. 2278];

(2) that Dr. Steenbock testified that he had tried sunlight and got activation prior to the filing of the application [R. 537];

(3) that the claims not only cover, but were also intended to cover solar irradiation, and

(4) that the alleged disclaimer was inserted in the specification after the application was filed, at the time a limited claim was added, and that thereafter, the limited claim was abandoned, and the all-inclusive claim in the patent was obtained.

all of which appears in much more detail in the majority opinion. [R. 3322-3330, 146 F. (2d), at pp. 947 and 948.]

Petitioner's Fifth and Sixth Questions. Re Claims Indefinite. (Petitioner's Br. pp. 43-56.)

Here again, petitioner is seeking a review of the evidence. It is attempting to distinguish the *General Electric Co. v. Wabash Co.*, 304 U. S. 364, and *United Carbon Co. v. Binney and Smith Co.*, 317 U. S. 228, cases because the claims in said cases "purported to define a product by its structural characteristics or physical form," whereas petitioner's claims "are claims for processes and resultant products that are not structurally definable." The majority opinion in disposing of this contention said [R. 3338]:

> "* * * There seems no distinction in principle between inadequate limitation of the monopoly area in such product and process claims."

That the majority opinion correctly disposed of the petitioner's contention is clearly shown by an analysis of this Court's opinions in the above-mentioned cases.

In *United Carbon Co. v. Binney & Smith Co.*, 317 U. S. 228, this Court held:

> "* * * Whether the vagueness of the claim has its source in the language employed or in the somewhat indeterminate character of the advance claimed to have been made in the art is not material. An invention must be capable of accurate definition, and it must be accurately defined, to be patentable. * * *"

In the *General Electric Co. v. Wabash Corp., supra*, this Court after holding that the patent under consideration failed to satisfy the requirements of R. S. 4888, 35 U. S. C. A. 33, which requires that the applicant "shall

particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery," said (304 U. S. 364 at p. 369):

> "* * * Patents, whether basic or for improvement, must comply accurately and precisely with the statutory requirement as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' The claims 'measure the invention.' * * *"

The above excerpt is quoted in both the aforesaid *United Carbon Co. v. Binney & Smith* case, *supra*, and in the majority opinion at pages 3332-3333 of the Record.

All of the claims of the first and second patents describe the function of exposure as "for a period *sufficient* to effect antirachitic activation but so limited as to avoid subsequent *substantial injury* of the antirachitic principle." As stated in the majority opinion, this language is too vague and uncertain a description of the process to "inform the public . . . of the limits of the monopoly asserted," as stated in the above-mentioned cases of this Court.

This is particularly true in this case since, as the majority opinion states [R. 3335-3336]:

> "There were many published ways in which the ultra violet rays were used to affect the chemistry of food prior to the filing of the first application on June 30, 1924. * * * In all these and other developments of the prior art and patenting, none of those discovering or seeking to discover valuable uses of the lamp's rays could determine just where Dr. Steenbock's 'sufficiency' of exposure would be infringed."

The function of exposure "so as to avoid subsequent substantial injury to the antirachitic factor" has no basis in fact, but is a mere economic or physiological factor, old in the art, a functional statement at the alleged point of novelty, vague and indefinite, and must be determined by experimentation. For example, with respect to whether the limitation in the claim meant from the standpoint of economic profit or dietary efficiency, the majority opinion, after quoting from Dr. Steenbock's testimony, states [R. 3335]:

> "* * * As to economic substantial injury, one who successfully activates food by the ultra violet rays would not violate the patent if the ultra violet rays were used sufficiently to cause an economic loss; while another would infringe if he processed a slightly more activated food at an economic gain. Or assuming two producers of irradiated foods of the same degree of exposure on the borderline of substantial injury, one of whom is a skillful salesman, the other less so. The first makes an economic gain and infringes; the second an economic loss and hence cannot be enjoined from further production of irradiated foods.

"Similarly as to the physiological effects of a 50 percent injury to the antirachitic factor from the function of over exposure, of which Dr. Steenbock speaks. If 50 percent injury be not substantial and 51 percent is substantial, the manufacturer of a product 51 percent injured by over exposure would not infringe."

Furthermore, this Court in *National Grain Yeast Corp.*, 308 U. S. 34, held a process patent invalid, holding at page 38:

"* * * But even if the process disclosed by Hayduck be held to constitute invention, the patent is invalid for indefiniteness as was held by the learned District Judge. Both the times and manner in which the concentrated nutrient solution is to be added may be ascertained as we have stated solely by experimentation. The disclosure of the patent is therefore too vague and indefinite to constitute invention."

The rule of the *General Electric Co. v. Wabash Corp.* case, *supra,* was applied in *Farmers' Cooperative Exchange v. Turnbow,* 111 F. (2d) 728.

The cases cited by the petitioner in connection with this question on pages 50-53 of its brief do not sustain the petitioner's contentions and are not applicable.

In none of the cases cited by the petitioner was the contention made that the claims were invalid because of indefiniteness, that is, because of the failure of the inventor "to inform the public during the life of the patent of the limits of the monopoly asserted."

In *Minerals Separation, Ltd., v. Hyde,* 242 U. S. 261, the contention was made that the claims were invalid for the reason that when different ores are treated preliminary tests had to be made to determine the amount of oil

and the extent of agitation necessary to obtain the best results—an entirely different question. In disposing of this contention, this Court held that the claims that included the "critical proportions" were valid and that the other claims were invalid. (The claims of the patent appear in the opinion of the Circuit Court of Appeals, 214 Fed. 100.) The language of this Court is as follows:

> "* * * the patent must be confined to the results obtained by the use of oil within the proportions often described in the testimony and in the claims of the patent as 'critical proportions' 'amounting to a fraction of one per cent. on the ore,' and therefore the decree of this court will be that the patent is valid as to claims Nos. 1, 2, 3, 5, 6, 7 and 12, and that the defendant infringed these claims, but that it is invalid as to claims 9, 10 and 11. * * *" (242 U. S. 261 at p. 271.)

The case at bar involves an entirely different factual situation. As stated above, the majority opinion held that the function of exposure as set forth in the claims "may mean (a) a sufficient substantial functioning from the viewpoint of economic profit or (b) from the viewpoint of its dietary efficiency." [R. 3333.]

The claims of the patents do not contain any critical limitations and differ from the prior art only in the use of conveniently functional language at the alleged point of novelty. The function of exposure is defined as "for a period sufficient to effect anti-rachitic activation but so limited as to avoid subsequent substantial injury of the antirachitic principle." [R. 2280.]

Neither of the specifications of the patents disclose how you would tell when the antirachitic principle has been imparted [R. 299], when the antirachitic principle is destroyed [R. 285, 299] or how to determine when "substantial injury to the antirachitic principle" occurs. In addition thereto, the record clearly shows that the first and second patents fail to disclose (1) how the intensity of the light affects the time of treatment, (2) how the distance of the material from the light source affects the time of treatment, (3) when to increase or decrease the time of treatment [R. 233], (4) when to increase or decrease the distance [R. 233], (5) what the various factors entering into the treatment of a material are, or when or how these factors will vary with the method employed [R. 233], (6) how intensity should be varied in treating different materials [R. 234], (7) how you would determine when a substance is antirachitic, (8) when a substance is overexposed [R. 299], (9) what maximum activation is [R. 315], (10) how a person would determine what is maximum activation [R. 315], or (11) what constitutes "substantial injury to the antirachitic factor."

As stated above, the other cases cited by the petitioner on pages 51 and 52 of its brief, namely, *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403; *Smith v. Snow*, 294 U. S. 1; *Waxham v. Smith*, 294 U. S. 20, and *Fullerton Walnut Growers Association v. Anderson-Barngrover Mfg. Co.*, 166 Fed. 443, are also not in point.

Because the claims of the patents are indefinite and functional at the alleged point of novelty, research and

progress in the field of irradiation is coerced. The language in the opinion is as follows:

> "* * * If the menace of doubt as to the excluded area of exposure hang over the scientific world there would be the weakening of inventive energy in this field, considered in the United Carbon and General Electric cases, *supra*." [R. 3336, 146 F. (2d) at p. 951.]

We submit that the claims are indefinite and that they are therefore invalid in that they fail to comply with the requirements of R. S. 4888, 35 U. S. C. A.

Petitioner's Seventh, Eighth and Ninth Questions. Re Hume and Smith and Goldblatt and Soames Publications. (Petitioner's Br. pp. 56-61.)

These questions relate solely to the Hume and Smith and Goldblatt and Soames publications. No question of law is presented. Petitioner is merely seeking to have this Court review the evidence and discuss particular facts in order to give the petitioner another hearing on matters peculiar to this controversy. As stated above, the writ of certiorari will not be granted "to review the questions of anticipation and invention" unless there is a conflict between decisions of Circuit Courts of Appeal.

The questions are obviously incomplete, misleading, and not based on the facts of this case. Complete answers with respect to the disclosures of the Hume and Smith and Goldblatt and Soames publications are found in the majority opinion on page 3366 of the record, and in the

minority opinion on pages 3343 and 3344 of the record, and will therefore not be repeated herein.

The American Graphophone Co. v. Leeds, et al., 87 F. 873 and *Dewey & Almy Chemical Co. v. Mimex Co.*, 124 F. (2d) 986, cases cited by the petitioner on pages 60-61 of its brief, relate to alleged anticipations which did not disclose the invention and are therefore not in point.

For example, with respect to the Hume and Smith publication, Ex. E-20, Steenbock and Nelson studied the publication, but did not agree with the positive results reported. See Ex. E-26, R. 2222. Dr. Nelson testified [Tr. 158] as follows:

> "* * * *In studying these results and attempting to justify the interpretations placed* upon them * * *. The British investigators Hume and Smith had not made clear whether or not they had removed everything from the jars when they were irradiated. They didn't state whether they had removed the food or the water that was normally kept in the cages or any litter, such as sawdust or shavings, usually kept in the bottom of the jar. *I then outlined certain studies to attempt to establish what the facts were and what factors were operative in these observations.* * * *." (Italics added.)

Not only did Dr. Steenbock and Dr. Nelson undertake this work, but when they conducted their experiments they reached an obvious conclusion and a logical interpretation of what Hume and Smith did. It is to be particularly noted that the conclusion was obvious and that the inter-

pretation was logical. Dr. Nelson's testimony is as follows [Tr. 161-162]:

> "* * * *This, obviously, led to the conclusion that there was something on these screens that was kept below the animals and which had been used before they were irradiated, that is, that there was something on the surface of those screens which was being affected by ultra violet rays and producing the growth effect on the animals.* * * *." (Italics added.)

In other words, this was not a case of creating something new but merely the demonstration of what had been done by Hume and Smith.

The same is true with respect to the Goldblatt and Soames publication, Ex. E-21. Steenbock's work merely duplicated the results reported by Goldblatt and Soames. His work involved no new thought and he produced no new result. Steenbock and Nelson admitted that the Goldblatt and Soames publication, Ex. E-21, teaches that they (1) were interested in rickets [R. 327]; (2) worked with rats suffering with rickets [R. 1758-1759]; (3) irradiated rachitic rats [R. 2866]; (4) produced Vitamin D in the liver of the irradiated rats [R. 218-19]; (5) found that the liver irradiated in the living rat was activated [R. 2100]; (6) fed the antirachitically activated liver to rachitic rats and cured rickets [R. 219]; (7) and the irradiation produced something in the rat which could be fed another rat to cure rickets. [R. 219.]

Petitioner's Tenth Question. Re Yeast Patent.
(Petitioner's Br. pp. 61-64.)

This question is also misleading, incomplete, and not in accordance with the facts in this case.

The application for the third patent is not a divisional application. It is merely a continuation-in-part of the second application. No mention whatever is made in the question of:

(1) that claims directed to the activation of yeast were inserted by amendment in the application which matured into the first patent. [R. 2574.] The Patent Office objected to the addition of the claims on the ground that yeast was not an ordinary food and hence the claims were for new matter. No appeal was taken, and the petitioner cancelled the claim, though petitioner contends that yeast is "an organic substance of dietary value," covered by the first patent in suit, and asserts that respondent is infringing that claim;

(2) that Hess in July, 1927, published his discovery of the activation of yeast and gave it freely for the benefit of rachitic children, without seeking a monopoly profit;

(3) that in 1928 Fleishmann obtained a license from petitioner to irradiate yeast;

(4) that the yeast tablet claim was voluntarily withdrawn in 1932 and that no attempt whatever was made to insert the claims in the application which matured into the second patent in suit, and

(5) the six year delay between the time that a claim directed to activated yeast or a process of activating yeast was cancelled from one application and presented in another application.

In other words, although Steenbock successfully irradiated yeast prior to June 30, 1924, the yeast patent did not issue until October, 1936,—more than twelve years later. Furthermore, although petitioner granted Fleishmann a license to irradiate yeast in 1928, no claim directed to the activation of yeast was pending in any application from 1926 to 1932.

As stated in the majority opinion at R. 3339:

> "In the vernacular of a not remote past, the profitable antirachitic yeast was an 'ace-in-the-hole' in the hand dealt when the discovery was made in 1924, but held until the showdown at the third application, eight years later."

The facts in this case, as outlined in the majority opinion [R. 3338-3340] and above, come squarely within the cases quoted in the majority opinion [R. 3338-3340], namely, *Webster Electric Co. v. Splitdorf Electric Co.*, 264 U. S. 463; *Woodbridge v. United States*, 263 U. S. 50, and *Wirebounds Patents Co. v. Saranac Automatic Machine Corp.*, 65 F. (2d) 904, 905. In the latter case, after discussing the above-mentioned cases of this Court and *Chapman v. Wintroath*, 252 U. S. 126, the Court stated at page 906:

> "The rationale of these three cases is that if the inventor, intentionally or by reason of culpable neglect, be guilty of action which unduly postpones the time when the public would be entitled to the free use

of the invention, and thus defeats the policy of the patent law, the right to a patent will be lost."

The cases cited by the petitioner are not in point.

In *Overland Motor Co. v. Packard Motor Co.*, 274 U. S. 417, the Court answered the question "Did the applicant, in cancelling the claim which was finally rejected on May 20, 1911, abandon such claim or estop himself from thereafter seeking it through a new application?" in the negative. In that case, the divisional application was filed within four months after the claims were cancelled from the first application, and no product embodying the subject matter of the claims appeared on the market until the patent issued,—an entirely different factual situation. In this case, as set forth above, there was a delay of six years in presenting claims directed to activated yeast or a process of activating yeast to the Patent Office, and petitioner granted Fleishmann a license to activate yeast almost four years before the process claim was again presented to the Patent Office.

In *Crown Cork Co. v. Gutman Co.*, 304 U. S. 159, 160, this Court merely decided the question, "Does this Court's decision in *Webster Co. v. Splitdorf Co.* (264 U. S. 463) mean that, even in the absence of intervening adverse rights, an excuse must be shown for a lapse of more than two years in presenting claims in a divisional application regularly filed and prosecuted in accordance with patent office rules?" in the negative. That question is entirely different than the question presented by the facts in this case.

We respectfully submit that the petitioner has been guilty of gross laches with respect to this matter, and that

the following statement in the majority opinion, after a discussion of the facts, sets forth the logical application of the law to the facts [R. 3340]:

> "The Supreme Court has held that such laches deprives one of his right to a patent, and what it has said applies *a fortiori* to withholding the use of a simple remedy for the widely prevalent affliction of rickets among children."

Alleged Divergence of Views Expressed in Opinions of the Circuit Court of Appeals.

There is no basis for the petitioner's contention that the petition for certiorari should be granted because of the divergence of opinion expressed in the opinions below.

Even though the petitioner's contention in this respect was correct, it would still not warrant the grant of the writ of certiorari.

With respect to the first and second questions presented, all three judges concurred in holding "that such refusal to permit such irradiation (of oleomargarine) warrants the refusal of the equitable injunctive and accounting relief sought by the corporation, though we hold the public interest is served better by our decision that the patents are invalid." [R. 3485.]

With respect to the third and fourth questions presented, it cannot fairly be said that Judge Healy disagreed with the majority opinion on either of these questions, as the petitioner contends. It is true that Judge Healy said:

> "* * * Further, it appears to me doubtful that the claims are fairly subject to the criticism that they broadly include a monopoly of the use of sunlight. * * *" [R. 3341-3342.]

But it must also be remembered that Judge Healy said [R. 3345, 3346]:

> "* * * It must be remembered that sunlight by its own inherent process activates the vitamin D principle in both inert and living tissues and substances, albeit, because of unfavorable atmospheric conditions, sunlight is not effective in all cases. *Nevertheless it is clear that the artificial process differs in no essential particular from the natural one.* The intervention of the mercury vapour lamp—developed long prior to Steenbock—may adapt the natural process to wider fields, but in a patentable sense the process itself is as ancient as the sun. * * *" (Italics added.)

With respect to the fifth and sixth questions presented, it is true that Judge Healy expressed some doubt as to whether the claims should be held invalid because lacking in particularity in respect of the period of exposure. Judge Healy assumed that Steenbock discovered and sufficiently disclosed in his claims the most effective period of exposure, which assumption was incorrect. However, as set forth in the above-quoted portion of his opinion, Judge Healy held that nevertheless such a discovery would not amount to a patentable invention.

With respect to the seventh, eighth, ninth and tenth questions presented, petitioner admits that the three judges substantially concur in answering said questions.

From the above, it is apparent that there is little divergence of views expressed in the opinions below and that there is no basis whatever for the petitioner's contention in this respect.

Re Pages 12-29 of Petitioner's Brief.

Many of the statements in this part of the petitioner's brief in the sections entitled "Introduction," "Dr. Steenbock's Background in Contract With That of Other Investigators," "Advent of Dr. Steenbock's Inventions," "The Patents in Suit," "Public Benefits," and "Petitioner's Administration of the Patents in Suit" are immaterial, inaccurate, and misleading. To point out all of the immaterial portions, misstatements and inaccuracies would only serve to unduly lengthen this brief. We shall therefore only briefly consider some of the matters in the section entitled "Dr. Steenbock's Background in Contrast With That of Other Investigators."

Dr. Steenbock, prior to June, 1924 (Steenbock's alleged date of conception is October, 1923) was not recognized by the authors of published articles on rickets and ultra violet light as a contributor to the investigations relating to the mode of action of ultra violet rays or the cure and prevention of rickets.

Respondent's Exhibits No. E-1 (July, 1910), to No. E-23 (Oct. 1924), inclusive, are published articles that deal with vitamins, rickets, sunlight and artificially produced ultra-violet light. Dr. Steenbock's name is not referred to in any of the above exhibits. In Respondent's Exhibit No. E-18 (Jan. 1923), "The Etiology of Rickets," by Edwards A. Park, Department of Pediatrics, Yale University School of Medicine, Dr. Park reviews the field of rickets starting with Glisson in 1650, up to the time of publication. Dr. Park refers to 140 published

articles dealing with rickets, ultra violet light and related subjects. No reference is made to Dr. Steenbock or any of his publications.

Judge Healy correctly characterized Steenbock's work as follows [R. 3344]:

> "Steenbock was familiar with this experiment. (Referring to the work of Hume and Smith.) After studies and experiments of his own he became convinced that the improvement in the condition of the rats was attributable, not to the irradiation of the air, but to the irradiation and consequent activation of the sawdust, which is edible to rats. In other words, Steenbock accurately interpreted the results of Hume and Smith's experiments, the significance of which the latter themselves failed to comprehend.
>
> "In the same year Goldblatt and Soames published an account of another experiment, with which, also, Steenbock was familiar. They irradiated live rats with a quartz mercury vapour lamp, after which the livers were removed and fed to rachitic rats, with resultant marked improvement in growth. Thus by these scientists as well as by Hume and Smith the actual process of irradiating edible substances with the mercury vapour lamp had already been practiced. There had been, besides, other practices of natural or artificial irradiation of dietary substances, some of which are mentioned in the main opinion. I think, therefore, that Steenbock cannot fairly be said to be the originator of the process. His contribution to the art lies, rather, in his interpretation of the results that may be achieved by the process. * * *" (Parenthesis added.)

Summary.

Summarizing briefly, respondent submits:

1. Questions 1 and 2 with respect to the misuse of the patents are not properly presented in this case, in that the Circuit Court of Appeals did not base its decision on that ground.

2. Even though the Court had based its decision on the misuse of the patents, the Court would merely have been following the principle established in many recent decisions of this Court.

3. Even though the Court had based its decision on the misuse of the patents, the petition should still be denied, in that with respect to the remaining questions this case is an ordinary patent infringement case with the usual issues in patent infringement litigation of anticipation and invention, and there is no conflict of decision with respect to the pettioner's patents between two Circuit Courts of Appeal.

4. Even though the Court had based its decision on the misuse of the patents, the petition should still be denied as to the other questions presented, and a decision on the first and second questions alone would not entitle the petitioner to prevail since the Court held that the patents are invalid.

5. Since this is otherwise an ordinary patent infringement case, the fact that the petitioner has misused its patents should not be the basis of giving it another hearing on matters peculiar to this controversy.

6. Any divergence of views expressed in the majority and minority opinions of the Circuit Court of Appeals does not warrant the grant of certiorari.

7. The case does not involve any principle which is of importance to the public, other than the questions with respect to the misuse of the patents, and the Court did not base its decision on that ground.

8. There is no merit in the petitioner's contention that the decision in this case conflicts with previous decisions of this Court.

9. The first patent was found invalid on several grounds, in fact, in order to prevail on the first patent, each and every one of the first nine "Questions Presented" by the petitioner must be answered in accordance with the petitioner's contentions.

10. The third, fourth, seventh, eighth and ninth questions presented are merely questions of fact. No question of law is presented in any of said questions.

11. The claims of the patent are invalid because anticipated by immemorial agricultural and horticultural processes and the prior art.

12. The claims of the first two patents are invalid because of indefiniteness of the area of the claimed monopoly.

13. The principle of the *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, and *United Carbon Co. v. Binney & Smith*, 317 U. S. 228, cases is applicable to process claims as well as product claims.

14. The yeast patent is invalid because of laches.

15. There is little divergence of opinion expressed in the opinions of the Circuit Court of Appeals.

Conclusion.

In conclusion it is respectfully submitted that the decision of the Circuit Court of Appeals, here involved, has correctly decided all issues presented in the case, that the petitioner has no ground for writ of certiorari, and that the petition for writ of certiorari should be denied.

Respectfully submitted,

R. WELTON WHANN,
ROBERT M. MCMANIGAL,
Attorneys for Respondent.

Los Angeles, California, May 24, 1945.

Service of the within and receipt of a copy thereof is hereby admitted this.....day of May, A. D. 1945.

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Earl

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